

TOWNSEND and TOWNSEND and CREW LLP

By : \_\_\_\_\_ /Janet L. Newmaker/  
Janet L. Newmaker

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Bennett Cookson Jr. et al.

Application No.: 10/748,442

Filed: December 29, 2003

For: Providing Alternatives Within  
A Family Tree Systems And  
Methods

Customer No.: 20350

Confirmation No.: 2385

Examiner: Angela M. Lie

Art Unit: 2163

**APPELLANTS' BRIEF  
UNDER 37 C.F.R. § 41.37**

Mail Stop Appeal Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Further to the "Notice Of Appeal" and "Pre-Appeal Brief Request For Review" filed April 28, 2008, and the "Notice Of Panel Decision From Pre-Appeal Brief Review" mailed June 13, 2008, for the above-referenced application, Appellants submit this Brief on Appeal.

**1. Real Party In Interest**

The Generations Network, Inc., of Provo, Utah, is the real party in interest as the assignee of the above-identified application.

**2. Related Appeals And Interferences**

No other appeals or interferences are known that will directly affect, are directly affected by, or have a bearing on the Board decision in this appeal.

**3. Status Of Claims**

Claims 1-19 are currently pending in the application. All pending claims stand finally rejected pursuant to a final Office Action mailed December 27, 2007. The rejection of claims 1-19 is believed to be improper and is the subject of this appeal. The claims as rejected are attached as Appendix A.

Claims 1, 2, 11 and 12 stand rejected under 35 U.S.C. § 102(c) as being anticipated by the cited portions of U.S. Patent Publication No. 2005/0114364 to Tebbs et al. (“Tebbs”).

Claims 3-10 and 13-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Tebbs in view of the cited portions of U.S. Patent Publication No. 2004/0083226 to Eaton (“Eaton”).

**4. Status Of Amendments**

The claims have been amended one time in this case. An Amendment was filed November 21, 2006, in response to a non-final Office Action mailed August 23, 2006. No amendments have been entered subsequent to the final Office Action mailed December 27, 2007. This Appeal Brief is filed in response to the final Office Action.

**5. Summary Of Claimed Subject Matter**

In the following summary, the Appellants have provided exemplary references to sections of the specification and drawings supporting the subject matter defined in the claims as required by 37 C.F.R. § 41.37. The specification and drawings also include additional support for other exemplary embodiments encompassed by the claimed subject matter. Thus, it should be appreciated that the references are intended to be illustrative in nature only.

Claim 1 recites a method of creating a family tree depicted generally at Figure 2A. The method includes receiving a request from a user to return a file comprising the family tree (block 212); using a plurality of primary source records (¶[0025]) to construct the family tree based on the request (block 214 and ¶[0041]), wherein the records indicate multiple alternatives for at least one person of the family tree (¶[0043]), and wherein the records comprise correlated records having been subjected to one of an individual correlation process (block 206 and ¶[0036]) and a relationship correlation process (block 208 and ¶[0038]) to thereby determine a likelihood that two or more of the records represent at least one person (¶[0039]); sending a file comprising the family tree to the user, wherein the file comprises the alternatives (block 216).

Claim 11 recites a system for creating a family tree depicted generally at Figure 1. The processor (112) is programmed according to the method of Figure 2A to receive a request from a user to return a file comprising the family tree (block 212); use a plurality of primary source records (¶[0025]) to construct the family tree based on the request (block 214 and ¶[0041]), wherein the records indicate multiple alternatives for at least one person of the family tree (¶[0043]), and wherein the records comprise correlated records having been subjected to one of an individual correlation process (block 206 and ¶[0036]) and a relationship correlation process (block 208 and ¶[0038]) to thereby determine a likelihood that two or more of the records represent at least one person (¶[0039]); send a file comprising the family tree to the user, wherein the file comprises the alternatives (block 216).

Claim 19 includes all the elements of claim 11. Additionally, claim 19, which depends from claim 11 through claims 13, 14 and 17, recites wherein the processor is further programmed to provide an opportunity for the user to select among the alternatives (¶[0043]); receive a selection from among the alternatives from the user (block 220); store the selection (block 220); use the selection to revise the family tree (¶[0043]); send a file comprising the revised family tree to the user (¶[0043]); receive additional genealogy data that creates new alternatives in the family tree (block 222); and notify the user of the new alternatives (block 224). Further, in being programmed to notify the user of the new alternatives, the processor is further programmed to send the user a file comprising the family tree, wherein the file includes a new alternatives symbol (408 and ¶[0069]).

## **6. Grounds Of Rejection To Be Reviewed On Appeal**

Issue 1: Whether claims 1, 2, 11 and 12 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by the cited portions of U.S. Patent Publication No. 2005/0114364 to Tebbs et al. ("Tebbs").

Issue 2: Whether claims 3-10 and 13-19 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Tebbs in view of the cited portions of U.S. Patent Publication No. 2004/0083226 to Eaton ("Eaton").

## **7. Argument**

Issue 1: Whether claims 1, 2, 11 and 12 were properly rejected under 35 U.S.C. § 102(e) as being anticipated by the cited portions of U.S. Patent Publication No. 2005/0114364 to Tebbs et al. ("Tebbs").

The Appellants maintain that the rejections of claims 1 and 11 under 35 U.S.C. § 102(e) are improper. Under 35 U.S.C. § 102 “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). That is not the case here.

Claim 1 recites:

1. A method of creating a family tree, comprising:  
receiving a request from a user to return a file comprising the family tree;  
using a plurality of primary source records to construct the family tree based on the request, wherein the records indicate multiple alternatives for at least one person of the family tree, and wherein the records comprise correlated records having been subjected to one of an individual correlation process and a relationship correlation process to

thereby determine a likelihood that two or more of the records represent the at least one person;

          sending a file comprising the family tree to the user, wherein the file comprises the alternatives.

Tebbs is cited for teaching all the elements of claim 1, but Tebbs does not teach multiple alternative records for at least one person. Tebbs appears to teach a system and methods to “quantify the quality of genealogical data.” (See Tebbs, ¶[0025].) Fig. 4, in particular, depicts a record for an individual having multiple layers of attributes (i.e., “pieces of information associated with an individual”; ¶[0027]). Tebbs teaches a method wherein users may rate the quality of the information presented for an individual, but Tebbs does not teach “records [that] indicate multiple alternatives for at least one person of the family tree” as recited in claim 1.

Moreover, while Tebbs appears to teach a rating system for genealogical data, Tebbs does not teach either an individual correlation process or a relationship correlation process that “determine a likelihood that two or more of the records represent the at least one person.” Hence, for at least the foregoing reasons, the rejection of claim 1 is believed to be improper. Claim 11 includes similar elements and is believed to be allowable, at least for the same reasons.

Issue 2: Whether claims 3-10 and 13-19 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Tebbs in view of the cited portions of U.S. Patent Publication No. 2004/0083226 to Eaton (“Eaton”).

Claim 19 depends from claim 11 and is believed to be allowable by virtue of that dependency. Moreover, claim 19 is believed to be allowable for the additional reason that neither Tebbs nor Eaton teaches or suggests “providing an opportunity for the user to select among the alternatives; . . . thereafter, receiving additional genealogy data that creates new alternatives in the family tree; and notifying the user of the new alternatives, wherein notifying the user comprises sending the user a file comprising the family tree, wherein the file includes a new alternatives symbol.” As discussed above, Tebbs does not teach alternatives for individuals, although Tebbs appears to teach a rating system for data relating to a particular individual.

Eaton does not cure the deficiency. Eaton appears to teach methods for improving the efficiency of downloading, but is specifically limited to structures in which only different individuals are represented. (See Eaton, ¶[0041].) Hence, neither Eaton nor Tebbs teach or suggest the elements quoted above. Hence, claim 19 is believed to be allowable, at least for this additional reason.

#### 8. Conclusion

For these reasons, it is respectfully submitted that the rejections should be reversed.

Respectfully submitted,

Date: July 14, 2008

/Irvin E. Branch/

Irvin E. Branch  
Reg. No. 42,358

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, CA 94111-3834  
Tel: 303-571-4000  
Fax: 415-576-0300  
IEB/jln  
61416092 v1

**9. Claims Appendix**

1. (Previously Presented) A method of creating a family tree, comprising:  
receiving a request from a user to return a file comprising the family tree;  
using a plurality of primary source records to construct the family tree based on the request, wherein the records indicate multiple alternatives for at least one person of the family tree, and wherein the records comprise correlated records having been subjected to one of an individual correlation process and a relationship correlation process to thereby determine a likelihood that two or more of the records represent the at least one person;  
sending a file comprising the family tree to the user, wherein the file comprises the alternatives.
2. (Original) The method of claim 1, wherein an alternative results from a difference relating to a selection from the group consisting of spelling, place, date, event relationship, ancestor, spouse, and children.
3. (Original) The method of claim 1, further comprising, providing an opportunity for the user to select among the alternatives.
4. (Original) The method of claim 3, further comprising:  
receiving a selection from among the alternatives from the user;  
storing the selection;  
using the selection to revise the family tree; and  
sending a file comprising the revised family tree to the user.
5. (Original) The method of claim 4, further comprising, using the selection to provide an alternative to another user.

6. (Original) The method of claim 4, further comprising, thereafter receiving a non-contemporaneous request from the user to view the family tree;
  - using the stored selection to construct the family tree; and
  - sending a file comprising the family tree to the user, wherein the family tree comprises the revised family tree.
7. (Original) The method of claim 4, further comprising, thereafter, receiving additional genealogy data that creates new alternatives in the family tree; and notifying the user of the new alternatives.
8. (Original) The method of claim 7, wherein notifying the user comprises sending the user an email.
9. (Original) The method of claim 7, wherein notifying the user comprises sending the user a file comprising the family tree, wherein the file includes a new alternatives symbol.
10. (Original) The method of claim 9, further comprising:
  - receiving a request from the user to view the new alternatives;
  - sending a file to the user comprising the new alternatives;
  - receiving a selection from among the new alternatives from the user;
  - using the selection to construct a revised family tree; and
  - sending a file comprising the revised family tree to the user.

11. (Previously Presented) A system for creating a family tree, comprising a processor programmed to:

receive a request from a user to return a file comprising the family tree;

use a plurality of primary source records to construct the family tree based on the request, wherein the records indicate multiple alternatives for at least one person of the family tree, and wherein the records comprise correlated records having been subjected to one of an individual correlation process and a relationship correlation process to thereby determine a likelihood that two or more of the records represent the at least one person;

send a file comprising the family tree to the user, wherein the file comprises the alternatives.

12. (Original) The system of claim 11, wherein an alternative results from a difference relating to a selection from the group consisting of spelling, place, date, event relationship, ancestor, spouse, and children.

13. (Original) The system of claim 11, wherein the processor is further programmed to provide an opportunity for the user to select among the alternatives.

14. (Original) The system of claim 13, wherein the processor is further programmed to:

receive a selection from among the alternatives from the user;

store the selection;

use the selection to revise the family tree; and

send a file comprising the revised family tree to the user.

15. (Original) The system of claim 14, wherein the processor is further programmed to use the selection to provide an alternative to another user.

16. (Original) The system of claim 14, wherein the processor is further programmed to:

thereafter receive a non-contemporaneous request from the user to view the family tree;

use the stored selection to construct the family tree; and

send a file comprising the family tree to the user, wherein the family tree comprises the revised family tree.

17. (Original) The system of claim 14, wherein the processor is further programmed to receive additional genealogy data that creates new alternatives in the family tree; and

notify the user of the new alternatives.

18. (Original) The system of claim 17, wherein in being programmed to notify the user of the new alternatives, the processor is further programmed to send the user an email.

19. (Original) The system of claim 17, wherein in being programmed to notify the user of the new alternatives the processor is further programmed to send the user a file comprising the family tree, wherein the file includes a new alternatives symbol.

**10. Evidence Appendix**

No additional evidence is provided.

**11. Related Proceedings Appendix**

No additional proceedings are in process.